

Remarks

In view of the above amendments and the following remarks, reconsideration and further examination are requested.

The specification and abstract have been reviewed and revised to make a number of editorial revisions. A substitute specification and abstract have been prepared and are submitted herewith. No new matter has been added.

As requested in the Office Action, replacement Figures 1-27B are enclosed herewith. It is submitted that these replacement drawings constitute formal drawings.

The Applicants hereby request that the Information Disclosure Statements filed with the U.S. Patent and Trademark Office on April 9, 2002 and February 24, 2005 be considered by the Examiner. The Applicants also request that the Examiner return initialed copies of the forms PTO-1449 which were filed as part of the Information Disclosure Statements of April 9, 2002 and February 24, 2005.

Further, it is requested that the Examiner confirm that the claim of foreign priority has been acknowledged. In the Office Action Summary, the Examiner has check box (12) and sub-box (a). However, sub-sub-box (1) which states that the certified copies of the priority documents have been received has not been checked. Therefore, such confirmation of the acknowledgement of the claim of priority is respectfully requested.

Claims 1-13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Small (US 5,791,991).

Claims 1, 9, 10, 12 and 13 have been amended so as to further distinguish the present invention from the reference relied upon in the rejection.

Further, it is noted that claim 11 has been cancelled without prejudice or disclaimer to the subject matter contained therein.

In addition, claims 1-10, 12 and 13 have been amended to make a number of editorial revisions. These revisions have been made to place the claims in better U.S. form. None of these amendments have been made to narrow the scope of protection of the claims, nor to address issues related to patentability and therefore, these amendments should not be construed as limiting the scope of equivalents of the claimed features offered by the Doctrine of Equivalents.

The above-mentioned rejection is submitted to be inapplicable to the claims for the following reasons.

Claim 1 is patentable over Small, since claim 1 recites a data transmission system having a first data terminal device on a bonus awarding side; a second data terminal device for a user who is entitled to receive a bonus; and a server, wherein the first data terminal device includes a first bonus identifier storage for storing, as an internal bonus identifier, a bonus identifier provided to uniquely identify a bonus awarded to the second data terminal device, the second data terminal device includes a bonus-attached file requesting part for requesting a bonus-attached file which is for the bonus, the bonus attached file including a bonus identifier which uniquely identifies the bonus, and a second bonus identifier storage for storing, as an external bonus identifier, the bonus identifier included in the bonus-attached file requested by the bonus-attached file requesting part, the first data terminal device also including a bonus identifier requesting part for requesting, through data communication with the second data terminal device, the external bonus identifier stored in the second bonus identifier storage, a determination part for determining whether or not the external bonus identifier requested by the bonus-identifier requesting part is the same as the internal bonus identifier stored in the first bonus identifier storage, and a bonus awarding part for providing, when the determination part determines that the external bonus identifier is the same as the internal bonus identifier, the second data terminal device with the bonus specified by the internal bonus identifier, and the server is operable to perform data communication between the first and second data terminal devices for a user of the first data terminal device to initiate and configure the bonus attached file based on input data. Small fails to disclose or suggest these features of claim 1.

Small discloses a system whereby a consumer is able to play a match game for a prize and also receive coupons and/or rebates regardless of whether they win the prize. The system includes a centralized database 1 where the match games 6 and the coupons/rebates 7 are stored. The system also includes an interactive device, such as a personal computer 15, an in-store kiosk 16, and/or an interactive television 21 by which the consumer can access the database 1 from a webpage 11 via the internet. (See column 5, lines 1-40 and Figure 1).

The system of Small operates by initially having the consumer play the match games 6 via the interactive device and then, regardless of the result of the matching game, prompting the user to enter a number of products for which they are interested in receiving coupons and/or

rebates. The database 1 then sends information to the interactive device of the user which allows the user to print out the relevant coupons and/or rebates. The coupons and/or rebates can be personalized to the user based on information provided by the user to the database 1 via the interactive device. The user can then either mail or scan the coupons and/or rebates and a proof of purchase for submission to a processing center for processing. (See column 7, line 50 – column 8, line 38 and Figure 2).

Initially, the Examiner has indicated that a number of the features recited in claim 1 are inherent “because modification and interpretation of the cited disclosure of Small would have provided means for ‘an interactive electronic display terminal....’ ... based on the motivation to modify Small so as to ‘provide an improved consumer product promotion method....’” However, it is respectfully submitted that this rationale is insufficient to met the requisite burden for establishing inherency and essentially states that the features are inherent because interpreting Small to inherently include the recited limitations would provide an improved product promotion method.

As is clearly set forth in M.P.E.P. §2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Further, M.P.E.P. §2112 states that in order for an Examiner to rely on the theory of inherency, he/she must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. It is apparent that the indication that interpreting Small to inherently include the recited limitations would provide an improved product promotion method does not meet the standard set forth above.

Additionally, it is apparent that the features recited in claim 1 do not necessarily flow from Small. For example, the first data terminal device having the determination part for determining whether or not the external bonus identifier requested by the bonus-identifier

requesting part from the second data terminal device is the same as the internal bonus identifier stored in the first bonus identifier storage of the first data terminal device, and the bonus awarding part for providing, when the determination part determines that the external bonus identifier is the same as the internal bonus identifier, the second data terminal device with the bonus specified by the internal bonus identifier do not necessarily flow from Small. As a result, it is apparent that the rejection lacks proper support for the conclusion that the features recited in claim 1 are inherent in Smith.

Further, the interactive device of Smith is used to select products of interest from a list of products previously stored in the database 1 by way of the website 11. The database 1 then transmits the relevant coupons and/or rebates back to the interactive device where they can be printed. In other words, the listing of products is provided by the database 1 to the interactive device for selection by the user. Therefore, there is never a condition where a request from the interactive device will not be handled by the database 1. As a result, it is apparent that neither the interactive device, nor the database 1, includes a determination part for determining whether or not an external bonus identifier requested by a bonus-identifier requesting part from the other of the interactive device and the database 1 is the same as the internal bonus identifier stored in the interactive device or the database 1. The interactive device and the database 1 also fail to include a bonus awarding part for providing, when the determination part determines that the external bonus identifier is the same as the internal bonus identifier, the other of the interactive device or the database 1 with the bonus specified by the internal bonus identifier, since the system of Smith is such that this type of condition does not exist.

It is also noted that the system of Small has two primary components, the database 1 and the interactive device (e.g., the personal computer 15, in-store kiosk 16, and/or an interactive television 21 used by the customer). However, claim 1 recites three main components, including the first data terminal device on the bonus awarding side, the second data terminal device for the user who is entitled to receive the bonus, and the server. It is apparent that Small cannot be interpreted as disclosing the first and second terminal devices and the server as recited in claim 1.

In addition, Smith fails to disclose or suggest a server that is operable to perform data communication between the first and second data terminal devices for a user of the first data terminal device to initiate and configure the bonus attached file based on input data. There is no

disclosure or suggestion in Smith of a server that allows a user to initiate and configure a coupon or rebate. Instead, the interactive device only allows a customer to print a coupon and/or rebate that is preexisting on the database 1. As a result, it is submitted that claim 1 is patentable over Smith.

As for claims 9, 10, 12 and 13, they are patentable over Smith for reasons similar to those set forth above in support of claim 1. That is, claims 9, 10, 12 and 13 each recite one or more of the features of claim 1 discussed above and not disclosed or suggested by Smith.

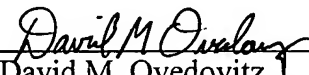
Because of the above-mentioned distinctions, it is believed clear that claims 1-10, 12 and 13 are allowable over Smith. Furthermore, it is submitted that the distinctions are such that a person having ordinary skill in the art at the time of invention would not have been motivated to modify Smith or to make any combination of the references of record in such a manner as to result in, or otherwise render obvious, the present invention as recited in claims 1-10, 12 and 13. Therefore, it is submitted that claims 1-10, 12 and 13 are clearly allowable over the prior art of record.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. The Examiner is invited to contact the undersigned by telephone if it is felt that there are issues remaining which must be resolved before allowance of the application.

Respectfully submitted,

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May 10, 2005